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10/718,204	11/20/2003	Jordon D. Honeck	P0020462.00	9800
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER MANUEL, GEORGE C	
			ART UNIT	PAPER NUMBER
			3762	
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			08/31/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/718,204

Applicant(s)

HONECK ET AL.

Examiner

George Manuel

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-50 is/are pending in the application.
- 4a) Of the above claim(s) 17-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 30-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 49 and 50 are indefinite because it is unclear what is meant by a groove including an opening. The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 49 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Longitudinal openings do not appear to be subject matter that was described in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11-13, 15-16, 30-31, 33-41, 43, and 45-47, 49 and 50 are rejected under 35 U.S.C. 102(b) as anticipated by Boser et al (U.S. 5676694). Referring to claims 1 and 30, Boser et al. teach an elongate lead body, a conductive coil, a conductive wire, and a conductive component with a first groove that holds the coil. The groove is attached to a crimp sleeve that is slid over and crimped to a conductor (see figures 1, 2, 4, 6-7, and 13 and column 1, lines 35-64). Because the definition of a groove is a long furrow or channel, the Examiner considers the conductive component to be part 315 (see figure 4), and the second groove is the channel that runs perpendicular to the first groove that contains the uninsulated part of the wire. In the alternative, the Examiner considers the conductive component to be part 312, and the second groove is again the channel that contains the uninsulated part of the wire. In a second alternative, the Examiner considers the second groove to be the "curved portion" of the underside of the conductive component 315 holding the coil that is in contact with the crimping sleeve, which is crimped on the uninsulated portion of the wire, making an electrical connection between the coil and the wire (see figures 5-10). It is inherent to strip a wire, place the uninsulated portion of the wire into a crimping sleeve and crimp the crimping sleeve in order to provide an electrical connection between two components.

Regarding claims 2 and 31, Boser et al. teach that the sleeve protrudes from the groove (see figure 9). With reference to claim 3, Boser et al. disclose that the conductor extends within a lumen of the lead body, that the coil extends around an outer surface

of the lead, that the first side of the crimp sleeve is within a lumen of the lead and the protruding surface extends through the lead (see figure 13). With reference to claims 4-5, Boser et al. teach the cable has a proximal and distal portion with an insulative outer layer (see figure 4 and column 4, lines 54-59). Regarding claims 6 and 7, Boser et al. do not teach a first sidewall and second sidewall explicitly, but instead teach an outer circumference of the sleeve, having a first sidewall and a second sidewall that each extend to the opposite side (see figure 9).

With regards to claims 9 and 10, Boser et al. teach that the portion of the coil includes a single filar that can be welded or compressed within the groove (see figures 6-7 and column 4, lines 60-64). With reference to claims 11, 12, and 36-38, Boser et al. teach that the groove can contain a plurality of filars that are welded or compressed within the grooves as described above (see figures 9 and 10). Referring to claim 13, Boser et al. teach that the coil forms a defibrillation electrode (see figure 4 and column 3, lines 55-56). Regarding claims 16 and 34, the component in which the groove is formed is made of tantalum (see column 4, lines 35-37). With reference to claims 15, 33, 35, and 43, the grain orientation of the second groove is perpendicular to the first groove (see figures 4, 6-7, and 9-10). With reference to claims 39-41 and 45-47, the conductive component can be formed from platinum, stainless steel, or titanium (see column 4, lines 35-37). Claims 42 and 48 are considered to be product by process claims and therefore, the groove, the product, is being considered and the EDM process is not being considered. Further, Boser et al. teach the groove as described above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 14, 32, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boser et al. Boser et al. disclose the claimed invention, but do not disclose expressly welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the crimp sleeve with the two grooves as taught by Boser et al. with the welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively, because the Applicant has not disclosed that welding the wire within the

groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with crimping the conductor; forming the groove from tantalum, platinum, titanium, or stainless steel; a single groove for the second groove, respectively, as taught by Boser et al. because it secures the wire within the groove; the materials are biocompatible; and the single groove holds the wire, respectively, and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Boser et al. Therefore, it would have been an obvious matter of design choice to modify Boser et al. to obtain the invention as specified in the claims.

Further, Boser et al. disclose the claimed invention except for welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical lead as taught by Boser et al, with welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively since it was well known in the art that welding the wire within the groove, forming the conductive component of strip stock, and forming the second groove with a plurality of grooves, respectively, secures the wire within the groove; the material is biocompatible; and the plurality of grooves secures the wire in multiple places, respectively.

***Response to Arguments***

Applicant's arguments filed 6/18/07 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., longitudinal openings) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is inherent to strip a wire so a bare wire makes electrical contact with the crimping surface and to crimp the sleeve to prevent the sleeve from disengaging.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

/George Manuel/  
Primary Examiner  
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